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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BENGZON, GREG C

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/936,203	Applicant(s) BECKER ET AL.	
	Examiner Greg Bengzon	Art Unit 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This application has been examined. Claims 1-2 have been cancelled by applicant's request in the preliminary amendment filed November 8, 2001. Claims 3-20 (as described in the preliminary amendment filed on November 8, 2001) are pending.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file (Application No. 19910527.8, filed on March 9, 1999 in Germany).

The effective date of the subject matter described in the claims in this application is March 9, 1999.

Information Disclosure Statement

The IDS form submitted on March 25, 2002 is currently experiencing an image scan processing issue. The IDS form is currently not available on the US Patent Office File Viewer, and was therefore not available for consideration by the Examiner. The US Patent Office Customer Support Team is currently investigating the issue. There is no action required from the Applicant at this time.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features described below must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The following features described in Claims 3-20 must be shown in the drawings:

- Distributed hierarchical system
- Storage unit to store identifiers characterizing objects and contexts for managing the identifiers
- Container objects and context information
- Additional context that is unilaterally associated with any desired context
- Object identifications stored in lowest possible container object
- Identification context
- Connections between objects in the form of monikers
- A document provided as the smallest environment for a context
- Contexts provided for object operations

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

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is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

The applicant's disclosure includes references to such terms as ES-Auto and Active Directory Service without any description indicating how these tools are related to, configured and coupled into the system and method described as the invention.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3, 8, 10, 12, 17, and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to Claims 3 and 12, the applicant describes a distributed hierarchical system with contexts forming a plurality of indirection stages. Applicant's specifications do not sufficiently disclose the said distributed hierarchical system, the objects referred to in said system, said contexts and the meaning of said indirection stages.

With respect to Claims 8 and 17, the applicant describes connections between objects in the form of monikers. Applicant's specifications do not sufficiently disclose the meaning, format, and content of said monikers, as well as the process of allocating or creating connections between object using said monikers.

With respect to Claims 10 and 19, the applicant refers to global, central management functions. Applicant's specifications do not sufficiently disclose the meaning of said global, central management functions.

Though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in

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the art can make and use the invention without undue experimentation. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

The Examiner notes that specification was not enabling with respect to the said claims at issue, noting further that there was no considerable direction and guidance in the specification; that there was no evidence presented by the Applicant of a high level of skill in the art at the time the application was filed; and also no evidence presented that all of the methods needed to practice the invention were well known.

Claims 4-7, 9, 11, 13-16, 18, and 20 are rejected on the basis of their respective dependencies on Claims 3, 8, 10, 12, 17, and 19.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3-8, 10-17, and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferrel et al. (US Patent 5907837), hereinafter referred to as Ferrel .

With respect to Claim 3, Ferrel discloses a system for identifying objects in a distributed hierarchical system, comprising a storage unit to store identifiers characterizing the objects and contexts for managing the identifiers, the contexts forming a plurality of indirection stages and, within a context, names and identifiers for all contained objects are known and unique. (Figure 5-8, Column 7 Lines 5-65, Column 8 Lines 10-25, Column 11 Lines 5-65, Column 17 Lines 20-60)

With respect to Claim 4, Ferrel discloses the system as claimed in claim 3, the storage unit further storing container objects and context information for each container object, with the container objects containing other objects and the context information being hierarchically structured. (Figure 7-8, Column 22 Lines 40-65, Column 24 Lines 10-50)

With respect to Claim 5, Ferrel discloses the system as claimed in claim 4, the storage unit further storing additional contexts which are not hierarchically related that may be unidirectionally associated with any desired context to access information thereof. (Figure 15, Column 13 Lines 1-10, Column 16 Lines 60-65, Column 33 Lines 10-20)

With respect to Claim 6, Ferrel discloses the system as claimed in claim 4, wherein the objects have associated local object identifications stored in a lowest possible container object containing the objects, and the objects are able to be identified using a chain of object identifications. (Figure 14, Column 29 Lines 30-60, Column 30 Lines 1-65)

With respect to Claim 7, Ferrel discloses the system as claimed in claim 3, wherein the contexts include identification contexts for managing context identifications, the context identifications being associated with objects in the identification context and being valid and unique within the identification context. (Figure 15, Column 31 Lines 40-65, Column 32 Lines 1-10)

With respect to Claim 8, Ferrel discloses the system as claimed in claim 3, wherein connections between the objects are in the form of monikers. (Column 8 Lines 25-27)

With respect to Claim 10, Ferrel discloses the system as claimed in claim 3, wherein the contexts are provided for managing the identifiers of the objects for object operations including at least one of moving, copying and renaming, without global,

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central management functions being provided. (Column 11 Lines 15-35, Column 19 Lines 15)

With respect to Claim 11, Ferrel discloses the method as claimed in claim 3, wherein the distributed hierarchical system is an automation system. (Column 9 Lines 1-45)

With respect to Claims 12-17 and Claims 19-20, the applicant discloses a method with the same limitations as described in Claims 3-8, 10-11. Therefore Claims 12-17 and Claims 19-20 are rejected on the same basis as Claims 3-8, 10-11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrel et al. (US Patent 5907837), hereinafter referred to as Ferrel, as applied above to Claims 3 and 12, in view of Stern (US Patent 6161107).

With respect to Claims 9 and 18, Ferrel substantially discloses the system and method as claimed by the applicant, as presented in prior rejections for Claims 3 and 12.

However Ferrel does not disclose a system and method wherein a document is provided as the smallest environment for a context, with context information associated with the document being used for objects embedded in the document, and the document having a name allocated thereto.

Stern discloses an information component management system for enabling web-based distributed applications, wherein said components include textual data, images, and structure. (Figure 2 column 6 Lines 45-65, Column 7 Lines 1-5) The components are broken down into objects that are related to each other according to a hierarchical organization, and are independently deployed in a distributed environment. Stern discloses of containers that provide context for components to be arranged to interact with each other. (Column 10 Lines 55-65, Column 11 Lines 1-15) Stern

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discloses that a document may be provided as the smallest environment for a context.

Column 15 Lines 60-65, Column 16 Lines 1-30)

Ferrel and Stern are analogous art because they present concepts and practices regarding distributed hierarchical systems, using contexts and containers for components and objects in order to facilitate storage, retrieval, and preservation of all aspects of the original source of information. It is respectfully suggested that at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the teachings of Stern into the system and method of Ferrel, such that a document is provided as the smallest environment for a context, with context information associated with the document being used for objects embedded in the document, (Column 16 Lines 40-65) and the document having a name allocated thereto. The suggested motivation for doing so would have been, as Stern suggests, (Column 11 Lines 65, Column 12 Lines 1-5) in order to provide a facility to physically 'package' the distributed object components for presentation to the users, such that the components are displayed in substantially the same format as the original source format.

Therefore it would have been obvious to combine the teachings of Stern into the system and method of Ferrel in order to obtain the invention described in Claims 9 and 18.

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to the enclosed PTO-892 form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (571)272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcb

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